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REMARKS

Claims 6 to 28 are pending.

Claims 1 to 5 are canceled.

Claims 6 to 8, 10, and 13 to 28 were previously presented.

No claims are amended in this paper.

Claim Rejections - 35 U.S.C. § 103

In the Office Action, Claims 6 to 28 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,098,631 in view of Bridges (WO 98/37881). In the Office Action, it was stated that the '631 patent teaches inhibition of MEK1 for treating rheumatoid arthritis (RA), but it was acknowledged in the Office Action that the '631 patent does not teach the MEK inhibitors used in a method of the present invention. It was also stated that Bridges, on page 22, at lines 24-25, teaches the MEK inhibitor recited in instant claim 17 (i.e., 2-(2-chloro-4-iodophenylamino)-N-cyclopropylmethoxy-3,4-difluorobenzamide, or a pharmaceutically acceptable salt thereof). It was argued in the Office Action that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the MEK inhibitors useful in the present invention in a method of treating rheumatoid arthritis.

Applicants respectfully traverse the rejection because they believe that there was no reasonable expectation of success for using a MEK inhibitor to treat rheumatoid arthritis (RA) at the time the present application was filed. There is no evidence in the '631 patent or in Bridges to support the speculation of the '631 patent that the use of a MEK inhibitor to treat RA would be successful. Applicants believe that such evidence is required for a proper obviousness rejection (*In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); cited in the Manual of Patent Examining Procedure, 8th ed. Incorporating revision no. 2, 2004, §2145 (X)(B), page.2100-161).

The '631 patent discloses the MEK inhibitor, PD98059, and speculates that a MEK inhibitor might be useful for treating RA. However, the '631 patent does not provide any evidence (e.g., experimental data or literature references) suggesting that the use of a MEK inhibitor to treat RA would be successful. Bridges does not cure the deficiency of the '631 patent because Bridges also fails to provide any such evidence.

Applicants believe that evidence suggesting a reasonable expectation of success is required for obviousness. In a case on point, the Federal Circuit in *In re O'Farrell* characterized prior art references, known as the Polisky reference and the Bahl reference, as follows:

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"We agree with the board that appellants' claimed invention would have been obvious in light of the Polisky reference alone or in combination with Bahl within the meaning of §103. Polisky contained detailed enabling methodology for practicing the claimed invention, a suggestion to modify the prior art to practice the claimed invention, and evidence suggesting that it would be successful." (7 USPQ2d 1680, first column, last paragraph; emphasis added).

"The information in the Polisky reference, when combined with the Bahl reference provided such a reasonable expectation of success." (7 USPQ2d 1681, first column, last complete paragraph)

Thus, Applicants believe that evidence suggesting that the use of a MEK inhibitor for treating RA would be successful is required for there to be a reasonable expectation of success, but that the '631 patent and Bridges do not provide such evidence. Accordingly, Applicants believe that claims 6 to 28 are not obvious over U.S. Patent No. 6,098,631 in view of Bridges, and are patentable under 35 U.S.C. § 103(a).

Conclusion

In view of the above remarks, Applicants believe that the rejection is overcome and request reconsideration of claims 6 to 28.

Respectfully submitted,

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